

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN S. ALLERS
and
EDWARD W. RIDER JR.

Appeal No. 97-3555
Application No. 08/534,692¹

ON BRIEF

Before CALVERT, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 28 and 30 through 32, which are all of the claims pending in this application.²

¹ Application for patent filed September 27, 1995.

² Claims 1, 3-6, 8-10 and 22-26 were amended subsequent to the final rejection.

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We REVERSE.

BACKGROUND

The appellants' invention relates to a container for stabilizing a food dish. An understanding of the invention can be derived from a reading of exemplary claims 1, 15, 26 and 28, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Baraban	547,759	Oct. 15, 1895
Cannell	3,770,115	Nov. 6, 1973
Schlaupitz et al. (Schlaupitz)	5,269,430	Dec. 14, 1993
Edwards et al. (Edwards)	5,339,973	Aug. 23, 1994

Claims 1 through 28 and 30 through 32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cannell in view of Baraban and Schlaupitz.

Claims 11 through 28 and 30 through 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cannell in view of Baraban, Schlaupitz and Edwards.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 10, mailed January 27, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 9, filed November 4, 1996) and reply brief (Paper No. 11, filed February 28, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issue

We will not sustain the examiner's rejection of claims 1 through 28 and 30 through 32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner determined (answer, p. 5) that it was unclear whether the food dish or pie tin itself is also being claimed along with the container. We do not agree.

We turn first to independent method claim 28 which recites as the first step thereof "placing a food dish within a receiving shell." This clearly incorporates the food dish into the claimed subject matter. Thus, claim 28 and its dependent claims (i.e., claims 30 to 32) are not indefinite under 35 U.S.C. § 112, second paragraph.

Next we turn to independent claim 1 which recites a container for stabilizing a food dish wherein the bottom of the food dish is suspended above the floor of the receiving shell when seated within the receiving shell. This limitation, in our view, "breathes life and meaning into the claim" and is "essential to point out the invention defined by the claim." See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991). We note that our view is consistent with (1) the appellants' arguments that the prior art applied under 35 U.S.C. § 103 fails to suggest this limitation, and (2) the examiner's view that Cannell discloses the claimed invention but for this limitation. Thus, it is our determination that claim 1 incorporates the food dish into the claimed subject matter and defines the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. Accordingly, claim 1 and its dependent claims (i.e., claims 2 to 14) are not indefinite under 35 U.S.C. § 112, second paragraph.

We now turn to independent claim 26 which recites a container for stabilizing a pie tin wherein the bottom of the pie

tin is suspended above the floor of the receiving shell when seated within the receiving shell. This limitation, in our view, "breathes life and meaning into the claim" and is "essential to point out the invention defined by the claim" for the same reasons stated above with respect to claim 1. Thus, it is our determination that claim 26 incorporates the pie tin into the claimed subject matter and defines the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. Accordingly, claim 26 and its dependent claim 27 are not indefinite under 35 U.S.C. § 112, second paragraph.

Lastly, we turn to independent claim 15 which recites a monolithic container for stabilizing a food dish. It is our determination that the references to the food dish in claim 15 merely recite the intended use of the container since claim 15 does not depend on the food dish for completeness (as does claim 1). Thus, it is our determination that claim 15 does not incorporate the food dish into the claimed subject matter and defines the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. Accordingly, claim 15 and its dependent claims (i.e., claims 16 to 25) are not indefinite under 35 U.S.C. § 112, second paragraph.

The obviousness issues

We will not sustain the examiner's rejection of claims 1 through 28 and 30 through 32 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention

from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The teachings of the prior art applied by the examiner in the rejection of the claims on appeal are set forth in the appellants' brief (pp. 9 and 21) and the examiner's answer (pp. 5-8).

With regard to independent claims 1 and 26, we agree with the appellants' argument (brief, pp. 10-15 and 25-26) that the applied prior art does not suggest suspending the bottom of the food dish or pie tin above the floor of the receiving shell. Accordingly, the subject matter of claims 1 and 26 and their dependent claims (i.e., claims 2 to 14 and 27) would not have been prima facie obvious under 35 U.S.C. § 103.

With regard to independent claim 15, we agree with the appellants' argument (brief, pp. 21-22) that the applied prior

art does not suggest the claimed hinge member. In that regard, we note that Edwards' flanges 38 and 40 surround the perimeters of his tray 12 and cover 14, respectively. Thus, the flanges are not part of Edwards' hinge 16 which connects the tray 12 to the cover 14. Edwards does not disclose or suggest providing the first and second flanges of his hinge 16 with the protrusion and recess as recited in claim 15. Accordingly, the subject matter of claim 15 and its dependent claims (i.e., claims 16 to 25) would not have been prima facie obvious under 35 U.S.C. § 103.

With regard to independent claim 28, we agree with the appellants' argument (brief, p. 27) that the applied prior art does not suggest the claimed step of providing an entrapment force upon a **partial circumference**. In that regard, we note that Cannell provides an annular groove 24 which provides an entrapment force upon the **entire circumference**. Consistent with the appellants' disclosure, we interpret³ "**partial circumference**" to mean not the total circumference. Thus, Cannell's groove 24

³ In proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

does not provide an entrapment force upon a **partial circumference** as recited in claim 28. Accordingly, the subject matter of claim 28 and its dependent claims 30 to 32 would not have been prima facie obvious under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 28 and 30 through 32 under 35 U.S.C. § 112, second paragraph is reversed and the decision of the examiner to reject claims 1 through 28 and 30 through 32 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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APPLICATION NO. 08/534,692

APJ NASE

APJ CALVERT

APJ CRAWFORD

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 19 Jun 98

FINAL TYPED: